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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,962	11/27/2000	Larry A. Greenspan	08563-0087	5141

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EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,962

Applicant(s)

GREENSPAN ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 12/19/03. Claims 1-60 are pending.

Response to Arguments

2. On pages 17-18 of the 12/19/03 responses, the Applicant argues the newly added limitations, namely that healthcare information is automatically incorporated into an intermediate presentation to generate a final presentation.

In response, it is respectfully submitted that because the method (and system) of the Jeacock are computer-enabled, the functions are "automatically" performed (i.e. are performed or function in an automated manner). For example, in col. 5 lines 32-col. 6, line 24, Jeacock discloses that patient specific information (e.g. information on the procedure to be performed) is imported from a database.

Similarly, the combination of references, Jeacock in view of Microsoft PowerPoint, that has been provided to address the limitations of claim 39 also provides means for automatically incorporating (healthcare) information from a desktop application into a plurality of slides. Microsoft PowerPoint allows information (e.g. Clip Art images and text) to be selected and imported (i.e. automatically incorporated) into the slide presentations. (Parker: pages 195-198).

Therefore, while the addition of the term "automatically" to claims 1,20 and 39 has been noted, the amendment does not alter the Examiner's interpretation of the prior art, and does not overcome the prior art rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Jeacock et al (US Patent No. 6,014,630).

As per claims 1-19, Jeacock teaches a method for selecting a presentation template, incorporating information on a healthcare procedure for a recommended course of treatment into the presentation template, incorporating user-specific data into the template and generating and saving the final presentation. (Figures 3a,3b, 4, 7a-7c; col. 3, lines 56-col. 5, lines 20; col. 6, lines 5-19). Jeacock further discloses a method that allows the user to modify the final presentation by adding, removing, and otherwise altering information in the presentation and to display the final presentation. (col. 5, lines 1-44) The final presentation (i.e. document) formatted by the software linked to a system workstation (i.e. stored to a desktop application) and printed out for the patient. (col. 3, lines 59-col. 4, lines 15; col. 6, lines 5-24).

Claims 20-38 repeat substantially the same subject matter of claims 1-19 as a set of instructions embodied on computer readable medium, causing a computer to execute the series of steps recited in claims 1-19. As the underlying process has been

Art Unit: 3626

shown to be computer implemented and disclosed by the teachings of Jeacock in the above rejection of claims 1-19, it is readily apparent that the Jeacock reference includes a computer readable medium storing instructions to perform the recited functions on a computer. As such, these limitations are rejected for the same reasons provided in the rejection of claims 1-19, and incorporated herein.

Claims 1 and 20 have been amended to recite that healthcare information specific to the individual is automatically incorporated into a presentation to generate a final presentation. As per this limitation, see Jeacock: col. 5 lines 32-col. 6, line 24. Jeacock discloses that patient specific information (e.g. information on the procedure to be performed) is imported from a database.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 39-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeacock in view of Parker (Microsoft Office 4 for Windows for Dummies).

As per claims 39-60, Jeacock teaches a computer system for creating and revising customized presentations to provide healthcare information to patients. The system includes at least one computer workstation with memory means and input means to type or select patient specific health care information to be incorporated into

Art Unit: 3626

the presentation. (Figures 3a,3b, 4, 7a-7c; col. 3, lines 56-col. 5, lines 20) The system also includes software and one or more databases storing relevant data for presentation preparation. (col. 6, lines 5-19) Jeacock further discloses the use of templates for creating the presentations (col. 6, lines 5-24), but does not expressly discuss the use of slides as part of the user presentation.

Parker discloses that Microsoft Powerpoint allows users incorporate slides as part of a customized visual presentation. (Parker: pages 187-197) Microsoft PowerPoint also allows information to be automatically incorporated into the slide presentation. (Parker: pages 195-198) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Jeacock with the teaching of Parker to include slides with information that has been automatically incorporated as part of a customized patient presentation. One would have been motivated to do this to improve or increase the visual impact of the presentation and to provide a quick and efficient way for a user to review and/or reformat the final presentation.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sun et al (US 2002/0022973) disclose a system and method for customized patient information presentation.

Art Unit: 3626

- Beller et al (WO 97/12544) teach a method for customized healthcare presentations for patients.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RP


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